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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,751	11/09/2001	Johannes Van Sinderen	COH-12726	4155
40854	7590	09/22/2004	EXAMINER	
RANKIN, HILL, PORTER & CLARK LLP 4080 ERIE STREET WILLOUGHBY, OH 44094-7836			CAPUTO, LISA M	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,751

Applicant(s)

VAN SINDEREN, JOHANNES

Examiner

Lisa M Caputo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004 and 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-14 and 16-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 26 April 2004 and 21 June 2004 have been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-8, 11-13, 16-17, and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba et al. (U.S. Patent No. 6,285,916, from hereinafter "Kadaba") in view of Kumar (U.S. Patent No. 5,489,773).

Kadaba teaches a multi-stage parcel tracking system. Kadaba teaches that referring now in more detail to the drawings, in which like numerals refer to like parts throughout the several views, FIG. 1 shows a parcel tracking system 10 embodying the present invention in block diagram form. Referring to FIGS. 1 and 2, the system 10 includes an intelligent, hand-held, portable data entry and data processing device 12, of the type known as a personal digital assistant (PDA). The PDA 12 includes a touch-

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sensitive data entry and display screen 14 (as recited in claim 22 of the instant application) capable of interpreting handwriting and of defining button or key areas 15. For example, the screen may display a typewriter keyboard, a numeric keypad (as recited in claim 23 of the instant application), or buttons programmed to allow a user to cause certain operations to occur. A cursor controller 16 mounted on the housing of the PDA enables movement of a cursor on the screen 14 by manual manipulation of the controller 16 in a known manner. A preferred PDA for use in connection with the present invention is model Z-7000 manufactured by Casio. The PDA 12 includes a processor or CPU 17 which is operative to control various devices within the PDA. The processor 17 is connected to a screen driver circuit 14a, which operates the data acquisition and display functions of the screen 14. The processor also is connected to a memory device 18, which may be RAM (protected by a battery back up), a removable memory card, or other memory capable of use with a PDA. An input/output (I/O) circuit 20, connected to the processor 17, controls communications between the PDA and external devices through a modem 22, an infrared port 23, and a wand scanner 25. The modem may be an internal modem or a plug-in peripheral type, and preferably is a model XJACK fax modem card by Megahertz. The infrared port 23 is a known device commonly built into PDAs for communication with other PDAs and PCs. The wand scanner 25 is preferably a model Scanteam 6180 by Welch Allyn. The scanner 25 includes a light source and detector for reading bar codes as the tip 25 of the wand is swept across a bar code 30 as shown in FIG. 2. The tip 25 is made of hard, transparent glass or plastic to withstand repeated drawing across surfaces on which bar codes have been printed. The scanner

25 also includes within the wand a detector for detecting the light reflected from the bar code 30 and circuitry for decoding the detector output. A resulting signal containing the contents of the bar code 30 is transmitted to the I/O circuit 20 via a cable 27 plugged into a communications port of the PDA. The wand scanner may require a battery pack (not shown) for operating power. The battery pack can be attached to the PDA 12. The system 10 also may include a portable data acquisition device 35, such as a UPS DIAD device. The DIAD device incorporates an optical data port 37, which can transmit data to a compatible peripheral optical data port 38 that is plugged into a communications port of the PDA 12. Other portable data acquisition devices can be used, and they may be interfaced to an RS-232 port of the PDA in a conventional manner for data transfer with the PDA by known means, such as cable, RF link, infrared link, or optical link. The system 10 may further include a personal computer 40 or other computer equipped with an infrared port 42 compatible with the infrared port 23 of the PDA 12 (the mobile data acquisition device has a mechanical/electrical interface to set up communication with a data exchange station as recited in claim 8 of the instant application). The infrared port 42 is preferably that sold by AST. The principal use of this infrared link in the present invention is to upload tracking information acquired by the PDA into the PC 40. The PC 40 then can be used as a station to search for or print parcel delivery status information. With appropriate programming of the PC 40 and PDA 12, information can be downloaded from the PC into the memory 18 of the PDA. As alternatives to the infrared port, data communication between the PC and the PDA may be over known means, such as cable, RF link, infrared link, or optical link. As also shown in FIG. 1, the PDA 12

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may be connected to a remote central tracking computer 45 via normal or cellular telephone lines using the modem 22 and a compatible modem in the computer 45. In this way the PDA can access tracking information stored in the central computer 45 and can receive such information from the computer 45. A printer 48 may be included in the system and selectively connected to the PC 40 or the PDA 12 by appropriate cables. In addition to being used to scan bar codes, the wand 25 also is used to enter data via the touch-sensitive screen 14. This is done by engaging the tip 26 of the wand against the screen to enter data either by pressing buttons or keys 15 defined by the screen display, or by writing on the screen. In particular, a recipient of a parcel may use the wand to enter his or her signature into the PDA to verify receipt of the parcel. The signature information is stored in the memory 18 and is associated with other information related to the same package, such as a tracking identification number obtained by scanning the bar code 30 (the mobile data acquisition device has a memory adapted to store identification specific data as recited in claim 7 of the instant application). A system according to the present invention needs no stylus in addition to the wand 25 (see Figures 1-2, col 4 line 33 to col 5 line 55).

Further, Kadaba teaches that returning to FIG. 3, at block 303 a procedure for making a tracking query is indicated. The tracking procedure is illustrated in more detail in the flow chart of FIG. 6 and the screen sequence of FIG. 7. From the main menu as shown in FIG. 7A, the clerk taps the button "Track Packages" and is presented with a query mode selection screen as in FIG. 7B for selecting "Internal Deliveries," that is, deliveries checked in or out by the PDA 12, or "TotalTrack," which refers to an external

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tracking database stored in the remote central computer 45. Referring to FIG. 6, upon such entry of the type of query, at block 601, the processor determines which button, internal or external query, has been tapped. If an internal query has been selected, the clerk is presented with the screen of FIG. 7C and asked to select a query mode: by date, by name of recipient, by tracking number, or by location of intended recipients (searching by location so as to confirm whether the recipient is the addressee as recited in claim 16 of the instant application). The clerk taps the appropriate button on the screen. The clerk then may use the keypad display to enter the desired date, name, or at least the last three digits of the tracking number. If a query by location has been selected, the clerk is presented with a screen as in FIG. 7D containing a list of possible locations. Upon tapping a particular location, it is displayed in a window. The above selection step corresponds to data input block 603 in FIG. 6. After the query mode and request data have been entered, the processor determines which mode has been selected at block 604. If a recipient's name has been entered, at block 605 the processor accesses the memory 18 and retrieves a list of the tracking numbers of parcels that have been signed out to the identified person, sorted by date of delivery, and optionally the signatures associated with each delivery (as recited in claims 11-12 of the instant application). If a date has been entered, at block 606 the processor accesses the memory 18 and retrieves a list of the tracking numbers of parcels that have been signed out on that date, sorted by recipient, and optionally the recipients' signatures. This information may be displayed at block 607 in the manner shown in FIG. 7E. Information that does not fit on the screen 14 may be displayed by scrolling in a

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known manner. If a tracking number has been entered, at block 608 the processor accesses the memory 18 and retrieves the date and time the parcel corresponding to the tracking number was signed out, the name of the recipient, and optionally the recipient's signature. The display of the retrieved information on the PDA screen is shown in FIG. 7F. If a recipient location has been entered, at block 608a the processor accesses the memory 18 and retrieves and displays the dates and times, the recipients' names, and optionally the signatures for all parcels delivered or to be delivered at the selected location. Thus, tracking information acquired by the PDA 12 can be accessed at any time using the PDA, and particularly can be queried before the PDA memory has been loaded up to another computer. This is an important feature of the invention because it eliminates a period of time during which tracking information acquired and stored in a portable data acquisition device otherwise would not be accessible. If an external query has been selected, from block 602 in FIG. 6 the logic steps to block 609 for input of a query mode directed to a database file in the central tracking computer 45. Again tracking may be enabled by tracking number, name of sender or recipient, date, or location of sender or recipient (preferably plus the name of an organization). However, appropriate security identification may be required to permit the person making the query to have access, particularly to broad lists by recipient or by date. At block 610, the processor causes the modem 22 to initiate communication with the computer 45. At block 611, the processor determines which query mode has been selected. If a tracking number has been entered, at block 612 the processor accesses the database file in the computer 45 and retrieves the scan history of the parcel

associated with the entered tracking number. If a date and an organization have been entered, at block 613 a list of parcels received by the organization on the entered date is retrieved. If a sender's or recipient's name is entered, at block 614 a list of parcels sent by, received by, or in transit to the particular person is retrieved. The capability to retrieve the scan history of each parcel in these lists can be provided (see Figures 6, 7A-F, col 7 line 5 to col 8 line 16). Hence, regarding claims 1 and 12, Kadaba teaches a mobile data acquisition device, corresponding module, and method for use in deliveries that comprises a reader for reading machine readable data and an input system for receiving data that identifies the recipient of the object and data about the object by a digital signature.

Regarding claims 1, 12, 19-21, and 24 Kadaba fails to teach that the recipient identification reader is designed to read machine readable objects (independent claims 12 and 19), and more specifically, articles from the group consisting of magnetic cards, chip cards, and transponders (independent claim 1).

Kumar teaches an integrated portable device for point of sale transactions. Kumar teaches a handheld, portable device for processing point of sale transactions that includes a housing, a magnetic card reader, a numeric and alphabetic keyboard for entering information, and a barcode scanner for scanning product information. Kumar discloses that the magnetic card reader 40 may be any conventional reader suitable for reading credit card information encoded on a magnetic credit card 41 (FIG. 6) and carried and mounted by means not relevant hereto within housing 20 substantially adjacent to the first end 23 of housing 20 so as to allow an operator, whether a

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salesperson or customer, to wipe the magnetic stripe of the card across the exposed reading head 42 of magnetic card reader 40, as further discussed below. Of course, where credit card 41 employs a different information encoding method, such as optical or electrical, card reader 40 may be appropriately selected to respond to such other encoding method. A substantially planer card guide 43 for directing credit card 41 and its magnetic stripe into operative engagement with reading head 42 may be furnished and connected to housing 11 as with flat head screws 44 (see Figure 2, abstract, col 3, lines 45-61). Hence, Kumar teaches that it is well known in the art to have a comprehensive device which is able to identify a consumer and product by many different ways (i.e. magnetic card reader, barcode scanner, etc.). In addition, with regards to claims 19-21, it is well known in the art that the magnetic reader, when reading previously stored machine-readable identification data on a card, is able to determine the authenticity by accessing a network server.

In view of the teaching of Kumar, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a magnetic card reader to the data acquisition device in addition to the barcode scanner in order to be able to process more information regarding the parcel so as to have a more comprehensive tracking and identification unit. In addition, the use of a magnetic card reader to read a consumer's magnetic card is conventionally known to be a secure way to determine the authenticity of a recipient.

Regarding claims 3, 13, and 17 Kadaba teaches that the device includes an input unit to enter a personal identification code in the form of a tracking number or security

identification (see col 8) and regarding claim 6, the tracking system as described shows that the device includes a site-locating unit.

Regarding claims 4-5, Kadaba fails to teach that the device has a data processing unit to execute electronic payments and that the device has a mobile radio unit.

Kumar teaches that the communications assembly 110 allows device 10 to obtain approval of credit card transactions, and may include, alternatively or in combination, the components necessary to effect several different methods of obtaining such approval. For example, device 10 may include a conventional radio frequency transceiver 111, preferably employing spread spectrum modulation, to send the information necessary for approval to a base station 112 including a like transceiver 113, central processing unit 114, memory 115 and input/output circuit 116 connected to a telephone line. Base station 112 will call the credit card verification telephone number, forward the necessary information, and receive and radio back to device 10 approval or disapproval. If desired additional memory 117 may be included within communications assembly 110 to store the information necessary for approval and transmit all such information in one or more larger data batches, instead of transmitting each piece of information as it is read, scanned or entered in device 10. Data jacks suitable for direct serial data transmission may be provided in both device 10 and base station 112, and device 10 and base station 112 plugged together to effect transfer. A modem 118 and telephone jack may be installed within device 10, and device 10 plugged directly into the public telephone network to obtain transaction approval. Communications assembly 110

may be carried within and mounted by means not relevant hereto to housing 20 substantially adjacent to magnetic card reader 40 underneath keyboard 50 (see Figure 6, col 5 lines 38-64). Mobile radio units are well known and notoriously old in the art for transmitting information.

In view of the teaching of Kumar, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a data processing unit to execute electronic payments because this would make the system more comprehensive and would be able to accomplish more tasks in order to ensure proper delivery of packages. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a mobile radio unit because the advantages of transmitting information through a mobile radio unit are numerous (i.e. quick, efficient transmission).

3. Claims 10, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba in view of Scott et al. (U.S. Patent No. 6,484,260, from hereinafter "Scott"). The teachings of Kadaba have been discussed above.

Regarding claims 10, 14, and 18, Kadaba fails to teach that biometric data is received from the recipient.

Scott teaches a personal identification system. Scott discloses a portable, hand-held personal identification device for providing secure access to a host facility includes a biometric sensor system capable of sensing a biometric trait of a user that is unique to the user and providing a biometric signal indicative of the sensed biometric trait. A processing unit responsive to the biometric signal is adapted to compare the biometric

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signal with stored biometric data representative of the biometric trait of an enrolled person that is unique to the enrolled person, and to provide a verification signal only if the biometric signal corresponds sufficiently to the biometric data to verify that the user is the enrolled person. The verification signal includes information indicative of the enrolled person or the device. A communication unit, including a transmitting circuit, is adapted to transmit the verification signal to a host system (see abstract, Figure 1, col 6, lines 41-53).

In view of the teaching of Scott, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a biometric reader to obtain biometric data because biometric data is unique to each person and the identity of the recipient would definitely be confirmed. This is desirable because the sender and recipient will both be able to be confident that the package was delivered to the correct person, hence decreasing forgery and theft. In addition, it is appropriate to combine Kadaba and Scott because both systems are portable data acquisition devices that are utilized to ensure correct transactions.

Response to Arguments

4. Applicant's arguments filed 26 April 2004 and 21 June 2004 have been fully considered but they are not persuasive.

5. Examiner appreciates applicant's argument that Kadaba fails to teach or suggest a recipient identification reader that is designed to read articles selected from the group consisting of magnetic cards, chip cards, and transponders. Kadaba teaches a full range of identification and confirmation of delivery information. Kadaba teaches that the

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signature information of the recipient (which is converted into machine-readable data) is input into the device when the item is delivered. Hence, Kadaba does teach a recipient identification reader that reads machine-readable data via the entering of the digital data signature. In addition, Kadaba teaches that the signature information is stored in the memory 18 and is associated with other information related to the same package such as a tracking identification number obtained by scanning a bar code 30, which is also a machine-readable data item (see Kadaba, col 5, lines 44-55). However, Kadaba fails to teach that the article is selected from a group consisting of magnetic cards, chip cards, and transponders. The Kumar reference is used to overcome this deficiency. It is appropriate to combine Kadaba with Kumar for the following reasons. Kadaba is teaching a parcel tracking system that utilizes a barcode scanner in order to obtain information about the package and a digital signature capture in order to obtain information about the recipient. Hence, two means of obtaining data are utilized. Kumar is teaching that a portable information transaction device is able to function with both a barcode scanner and a magnetic card reader. It is well known in the art that barcode scanners, magnetic card readers, and digital signature input pads are conventional ways to obtain identification information from a user. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kumar to modify Kadaba by replacing the digital signature pad of Kadaba with the magnetic card reader of Kumar, so that the actual recipient of the package is more easily identified (i.e. a person's magnetic card is more authentic than just having someone sign their digital signature).

In response to applicant's argument that the examiner's conclusion of obviousness of Kadaba/Kumar is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kadaba would have a more desirable system if the additional component of a magnetic reader was introduced because the system would be more efficient (i.e. if a customer had to pay for the delivery or had a data card with information, the magnetic card reader would be utilized in order to both identify the user and complete the transaction). Kadaba discusses the desirability of using digital signature capture and bar code scanners for data capture, and it is well known in the art that a magnetic reader is a conventional and equivalent means for obtaining data. Hence, independent claims 1, 12, and 19 stand rejected as being obvious over Kadaba in view of Kumar.

In response to applicant's arguments that the Scott reference does not overcome the deficiencies with the Kadaba patent as it relates to claims 10, 14, and 18, examiner respectfully submits that Kadaba as modified by Kumar teaches the invention as recited in the independent claims and Scott teaches the limitation of having a biometric sensor, which is not taught in Kadaba or Kumar.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 5,313,051 to Brigida et al. which teaches a paperless parcel tracking system and U.S. Patent No. 5,648,770 to Ross which teaches an apparatus and method of notifying a party of a pending delivery or pickup.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lisa.caputo@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMC

September 16, 2004



DIANE I. LEE
PRIMARY EXAMINER